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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/578,277 | 05/25/2000 | Indira C. Prabhakar | 5205 P3005.01 | 6173 |

7590 08/09/2006

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EXAMINER

PENDLETON, BRIAN T

| | |
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| ART UNIT | PAPER NUMBER |
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2615

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,277

Applicant(s)

PRABHAKAR ET AL.

Examiner

Brian T. Pendleton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 5 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 5/19/06 have been fully considered but they are not persuasive. With regard to claims 1 and 2, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. There are no arguments pointing out how the combination of Gilmore and Hanson does not read on the claims.

Applicant's arguments, see page 7 of the Amendment, filed 5/19/06, with respect to claim 3 have been fully considered and are persuasive. The rejection of the claim 3 has been withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore in view of Hanson et al. Gilmore discloses an automatic medicine dispenser comprising an inherent on/off switch, keypad 10 for entering a code that provides access to a recording function (see paragraph 72), microphone 122 on personal message unit 112 for recording an oral message in the medication reminder device (see paragraph 81), said keypad also used for entering a month, date and time of day schedule (see paragraphs 17 and 84 which imply that the schedule is based on a pre-programmed time, day, date, and calendar). The oral message is recorded for the month, date, and time of day. Paragraph 74 discloses that audible and visible indicators are

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generated when a pre-programmed dosage of medicine is to be taken. Gilmore does not disclose that visible signal to alert the individual that it is time to take medicine is turned off in response to playing the oral message which is played upon pressing a play button. Hanson et al teach an audio prescription instruction device comprising playback button 20 which is used to play an oral message related to medicine that is to be taken. Therefore, it was well known at the time of invention to generate an audio message at the touch of a button. Furthermore, Examiner takes Official Notice that the use of a visible indicator indicating that a message is waiting to be played and playing the message upon activation of a button and turning off the visible indicator was well known at the time of invention, specifically in the form of telephone answering machines, voice mail applications, etc. The visible indicator advantageously was used as a pronounced signal to alert the user of a waiting message. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Gilmore per the teachings of Hanson et al and include a playback button to generate the audible message and signal the visible indicator (LED 24) before playing back the message for the purpose of reminding the user of an impending dosage time. Claim 1 is rejected. As to claim 2, there are multiple dosage times (one for each day of a calendar month as shown in figure 1A).

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore in view of Hanson et al as applied to claim 1 above, and further in view of Sekura et al. The combination of Gilmore and Hanson et al does not disclose changing the current month, date and time to a future period and playing messages recorded for the future period, and changing the month, date, and time to the current month, date and time. Sekura et al teach a prescription compliance device and method comprising a "FUTURE" option (see figure 6A) which allows

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the user to scroll through the further times medication is to be taken (see column 9 lines 6-21). Hence, Sekura et al teach changing time (via scrolling) to see when other dosages are to be taken. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the combination of Gilmore and Hanson et al by including a "FUTURE" option, per the teachings of Sekura et al, for the purpose of playing messages recorded for a future dosage month, date, and time of day for the benefit of confirming future dosing events.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. Pendleton whose telephone number is (571) 272-7527. The examiner can normally be reached on M-F 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian T. Pendleton
Primary Examiner
Art Unit 2615



btp